

REMARKS

Claims 1-28 are pending. Reconsideration and allowance of all pending claims are respectfully requested in light of the following remarks.

Rejections under 35 U.S.C § 103(a)

Claims 1-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,966,547 to Hagan et al. ("Hagan") in view of Parlante ("Linked List Basics") and U.S. Patent No. 5,319,778 to Catino ("Catino"). Applicant respectfully traverses the subject rejection on the grounds that the cited references are defective in establishing a prima facie case of obviousness with respect to the pending claims.

In *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), the Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 1741 (emphasis added).

As the PTO recognizes in MPEP § 2142:

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

In the present application, a prima facie case of obviousness does not exist for the claims, as herein amended, for the reasons set forth below.

MPEP 2143.03 states that "'All words in a claim must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." However, in the present matter, the Examiner has not shown that all words in the claims have been considered. For example, independent claim 1 requires *inter alia* "adding a new element to the end of the queue even when the queue is in a locked state immediately prior to execution of the add to end function" (emphasis added) As explicitly noted by the Examiner in paragraph 7 of the final Office action, the combination of Hagan and Parlante fail to teach this element. In paragraph 8 of the final Office action,

the Examiner cites Catino as remedying the recognized deficiencies of Hagan and Parlante in this regard, stating that "Catino does teach [at col. 7, lns. 25-47] 'adding a new element to the queue even when the queue is in a locked state immediately prior to execution of the add to end function.'" This same position was expressed in the Office action mailed June 22, 2007, in response to which Applicant respectfully argued that:

"Catino's teaching of the head pointer in a locked state and the tail pointer in a 'potentially lockable state' does not read on 'the queue is in a locked state,' which phrase is explicitly defined in the claims as comprising the state in which '[the] queue head pointer is null and [the] queue tail pointer does not point to the queue head pointer.' Catino explicitly states that the tail pointer 'is only locked when there is one list element in the linked list. In other words, there is no successor element since there is only one list element in the linked list.' Col. 7, ll. 33-36 (emphasis added). As has been previously noted, Applicant's claimed invention covers the situation in which the 'add to end' function is executed while the queue is locked because another function is accessing the queue to add/remove an element therefrom, as evidenced by the head pointer being null and the tail pointer not pointing to the head pointer (i.e., the queue is not empty). This situation is clearly not addressed by cited Catino passage.

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In paragraph 111 of the final Office action, the Examiner responds to the above-noted argument by stating that "one cannot show nonobviousness by attacking the references individually where the rejections are based on a combination of references." On the contrary, on the present case, Applicant is not attempting "attack the references individually;" rather, Applicant is identifying explicit errors in the Examiner's argument. In particular, the Examiner cannot concede that a reference or combination of references fail to teach a claim element, cite a secondary reference as teaching that element, and then refuse to entertain arguments that the secondary reference does not in fact teach that element. Accordingly, even assuming that the Examiner is correct in asserting that Parlante teaches "a locked state," the cited combination clearly fails to teach "'adding a new element to the queue even when the queue is in a locked state immediately prior to execution of the add to end function."

Moreover, with regard to the Examiner's response to Applicant's argument as set forth in paragraph 112 of the final Office action that "all queues have two ends, a head end and a tail end," Applicant notes that the term "end," wherever that term is used throughout the specification and claims, is used to denote the "tail end" (to use the Examiner's terminology) of a queue. The phrase "head end" never appears in the specification or claims--"front," "beginning," and "head" are used instead. Therefore, as is clear from the context of the specification and claims, "end," as used in the claims, refers solely and exclusively to the "tail end" (again, to use the Examiner's terminology) of the queue. Accordingly,

Catino's teaching of adding an element to the beginning of the queue does not read on adding an element to the end of the queue as recited in claim 1.

Thus, for at least the reasons set forth above, the Examiner's burden of factually supporting a *prima facie* case of obviousness with respect to independent claim 1 has clearly not been met, and the rejection under U.S.C. §103 should be withdrawn. Independent claims 11 and 15 include limitations similar to those of claim 1 and are therefore also deemed to be in condition for allowance for at least the same reasons as claim 1. Claims 2-10, 12-14, and 16-28 depend from and further limit independent claims 1, 11, and 15, and are therefore also deemed to be in condition for allowance for at least that reason.

Conclusion

It is clear from the foregoing that all of the pending claims are in condition for allowance. An early formal notice to that effect is therefore respectfully requested.

Respectfully submitted,


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